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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Workman Nydegger			LI, SHI K	
1000 Eagle Gate Tower			ART UNIT	
60 East South Temple			PAPER NUMBER	
Salt Lake City, UT 84111			2613	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/829,609

Applicant(s)

LIGHT, GRETA

Examiner

Shi K. Li

Art Unit

2613

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,10,12-14 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,10,12-14 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3, 5-7, 10, 12-14 and 16-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the limitations "the transceiver housing defining a pair of optical port within an interior of the transceiver housing" and "each of the optical port slots being in communication with a respective optical port" in lines 3-6 of the claim. Instant specification, as originally filed, does not describe these limitations in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 7 recites the limitations "defining an interior" and "the transceiver housing interior being partitioned into first and second optical ports by an interior wall of the transceiver housing" in lines 8-11 of the claim. These limitations are not described in the specification, as originally filed, in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 13 recites the limitation "a substantially box-shaped transceiver housing" in line 16 of the claim. Instant specification, as originally filed, does not describe the limitation in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-3, 5-7, 10, 12, 17-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benzoni et al. (U.S. Patent 5,337,398) in view of X2-MSA ("A Cooperative Agreement for a Small Versatile 10 Gigabit Transceiver Package" Issue 0.9, 31st July 2002).

Regarding claim 1, Benzoni et al. discloses in FIG. 14 an optical transceiver module comprising a transceiver housing 70 and a transceiver substrate 12 with electrical connector 16. It is clear from FIG. 14 that the housing has two sides (left and right), a top, a bottom and front and rear faces. Benzoni et al. teaches in FIG. 14 that the housing have slots at the top. Furthermore, Benzoni et al. teaches in FIG. 8 and FIG. 10 receive optical assembly and transmit optical assembly that define a longitudinal axes perpendicular to the transceiver substrate. The difference between Benzoni et al. and the claimed invention is that the transceiver housing of Benzoni et al. has port slots at the top instead of the bottom. However, it is obvious to one of ordinary skill in the art to design the slot at the bottom instead of the top because the cross section of a fiber is of round shape and can be rotated any angle without affecting the optical signal carried by the fiber. One of the purposes of the slot is for alignment so that fiber cable can only be plugged into the ports with the right orientation. These slots are called connector keys.

X2-MSA teaches on page 20, Section 6.12.1 that connector keys are used for /transmit/receiver polarity. Therefore, depending on whether the transmitter is on the left-hand side or the right-hand side, the slots can be put on the top or the bottom. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the port slots at the bottom, as taught by X2-MSA, in the optical transceiver module of Benzoni et al. The motivation for combining Benzoni et al. and X2-MSA is that X2-MSA is an industrial standard widely accepted by many manufacturers and the modifying products to conform to industrial standard makes the products interoperable with products from other vendors and increases market.

Regarding claim 2, FIG. 14 of Benzoni et al. indicates that the transmit optical sub-assembly and receive optical sub-assembly are positioned above an imaginary horizontal plane that bisects the transceiver module.

Regarding claim 3, X2-MSA teaches on page 14 that an application of an optical module is for providing optical network interface in a PCI adaptor.

Regarding claims 5-6, Benzoni et al. teaches in FIG. 9 electronic components, e.g., capacitors 22 and 24.

Regarding claim 7, Benzoni et al. teaches in FIG. 3 electrical connectors 16. Benzoni et al. teaches in FIG. 11 receive optical assembly 52 and transmit optical sub-assembly 50. X2-MSA teaches on page 12 a wall between the two ports of the transceiver.

Regarding claim 10, X2-MSA teaches on page 14 that an application of an optical module is for providing optical network interface in a PCI adaptor.

Regarding claim 12, Benzoni et al. teaches in FIG. 9 electronic components, e.g., capacitors 22 and 24.

Regarding claim 13, X2-MSA teaches on page 14 that an application of an optical module is for providing optical network interface in a PCI adaptor. Furthermore, X2-MSA teaches on page 14 a box-shaped transceiver housing.

Regarding claim 14, Benzoni et al. teaches in FIG. 9 electronic components, e.g., capacitors 22 and 24.

Regarding claim 16, Benzoni et al. teaches in FIG. 14 connector 16.

Regarding claim 17, X2-MSA teaches on page 14 that an application of an optical module is for providing optical network interface in a PCI adaptor.

Regarding claim 18, X2-MSA teaches on page 14 face plate.

Regarding claims 19 and 21, it is understood that the modified optical transceiver module of Benzoni et al. and X2-MSA is electrically connected to the host bus adapter.

5. Claims 13-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benzoni et al. and X2-MSA as applied to claims 1-3, 5-7, 10, 12, 17-19 and 21 above, and further in view of Poplawski et al. (U.S. Patent 6,551,117 B2) and Togami et al. (U.S. Patent 7,350,984 B1).

Benzoni et al. and X2-MSA have been discussed above in regard to claims 1-3, 5-7, 10, 12, 17-19 and 21. Furthermore, X2-MSA teaches on page 14 a box-shaped housing. To strengthen the rejection, the Examiner cites Poplawski et al. for teaching a box-shaped housing with slots at the bottom. Poplawski et al. teaches in FIG. 14 a transceiver with a circuit board. FIG. 14 shows receptacle openings 532 and 534 where there is a slot at the bottom of each opening. These slots are for standard duplex connectors (e.g., see FIG. 6A of Togami et al., U.S. Patent 7,350,984 B1). One of ordinary skill in the art would have been motivated to combine the

teaching of Poplawski et al. with the modified optical transceiver module of Benzoni et al. and X2-MSA because these slots are needed for accepting standard duplex connectors. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to have slots in a box-shaped housing, as taught by Poplawski et al., in the modified optical transceiver module of Benzoni et al. and X2-MSA because these slots are needed for accepting standard duplex connectors.

6. Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benzoni et al. and X2-MSA as applied to claims 1-3, 5-7, 10, 12, 17-19 and 21 above, and further in view of Branch et al. (U.S. Patent 6,485,322 B1).

Benzoni et al. and X2-MSA have been discussed above in regard to claims 1-3, 5-7, 10, 12, 17-19 and 21. The difference between Benzoni et al. and X2-MSA and the claimed invention is that Benzoni et al. and X2-MSA do not teach PCMCIA card. It is understood that PCMCIA cards are used in notebook computers. Branch et al. teaches in FIG. 1 an optical interface card with PCMCIA format. One of ordinary skill in the art would have been motivated to combine the teaching of Branch et al. with the modified optical transceiver module of Benzoni et al. and X2-MSA so that the module can be used with notebook computers. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to put the modified optical transceiver module of Benzoni et al. and X2-MSA in a PCMCIA card, as taught by Branch et al. so that the module can be used in notebook computers.

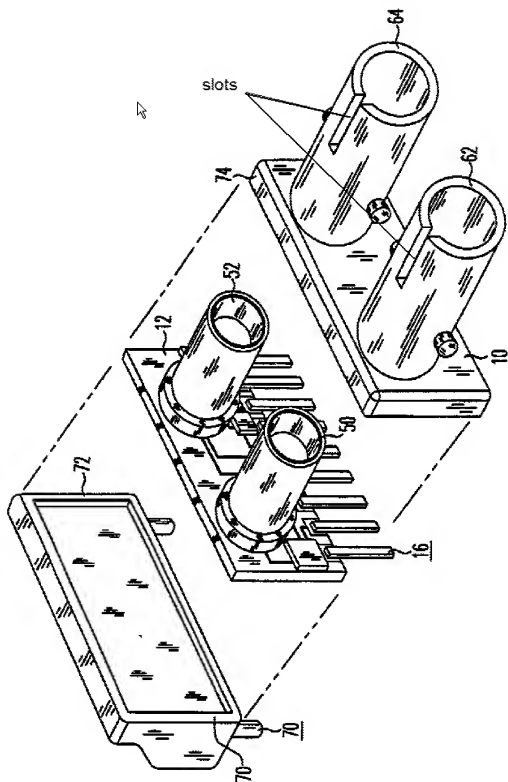
Response to Arguments

7. Applicant's arguments filed 15 August 2008 have been fully considered but they are not persuasive.

The Applicant argues that it is well established that "A description as filed is presumed to be adequate, unless or until sufficient evidence of reasoning to the contrary has been presented by the examiner to rebut the presumption... The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by preponderance of the evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." MPEP § 2163.04 (emphasis added), see also MPEP § 2163(II)(a) (confirming that "There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed... "). In the present case, the rejection stated by the Examiner is based on nothing more than the vague and conclusory assertion that "... specification, as originally filed, does not describe these limitations in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Office Action at 2-3. As the foregoing makes clear, the Examiner has presented no evidence or analysis whatsoever in support of the rejection. Applicant respectfully submits that mere conclusory assertions are plainly inadequate to overcome the "strong presumption that an adequate written description of the claimed invention is present in the specification as filed."

The Examiner disagrees. The paragraphs of MPEP cited by Applicant refer to the enablement requirement while the Examiner rejects the limitations based on new subject matter. Since Applicant fails to point out where the new limitation is supported, nor does there appear to be a written description of the claim limitation, in the application as filed, the rejection is proper. See MPEP §2163.04 I(B).

The Applicant argues that Benzoni failed to teach “transceiver housing”, “interior wall” and “bottom of the transceiver housing defining a pair of optical port slots...”. The Examiner disagrees. Benzoni et al. teaches in FIG. 14 shell pieces 72 and 74. They are joined together to form a package 70 which is equivalent to housing of instant claim. Furthermore, X2-MSA teaches on pages 10 through 18 figures illustrating housing of transceiver. X2-MSA also teaches on page 12 a wall separating two ports. Benzoni et al. teaches in FIG. 14 slots in the optical port. The Examiner reproduces below FIG. 14 of Benzoni et al. and indicates the slots.



8. In response to applicant's argument that if the circular Benzoni receptacles are replaced with the rectangular receptacles of Poplawski, as the Examiner has alleged would be obvious to do, the Benzoni receptacles would no longer be suited for their intended purpose, namely, to be able to interface with the connectors contemplated by that reference. That is, the modification proposed by the Examiner would render the Benzoni device non-functional for its intended use, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shi K. Li whose telephone number is 571 272-3031. The examiner can normally be reached on Monday-Friday (7:30 a.m. - 4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 571 272-3022. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

skl
12 November 2008

/Shi K. Li/
Primary Examiner, Art Unit 2613